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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,702	03/22/2004	Steven J. Winick	H0006502-0555 (17268)	8726

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EXAMINER
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LAFORGLA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2439

MAIL DATE	DELIVERY MODE
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02/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/805,702

**Applicant(s)**

WINICK, STEVEN J.

**Examiner**

Christian LaForgia

**Art Unit**

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-13, 15-18, 20, 28-32, 34-36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-13, 15-18, 20, 28-32, 34-36 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The amendment of 18 November 2008 has been noted and made of record.
2. Claims 1-7, 9-13, 15-18, 20, 28-32, 34-36, and 38 have been presented for examination.
3. Claims 8, 14, 19, 21-27, 33, and 37 have been cancelled as per Applicant's amendment.

***Response to Arguments***

4. Applicant's arguments, see page 8, filed 18 November 2008, with respect to claim objections have been fully considered and are persuasive. The claim objections of claims 14 and 33 have been withdrawn.
5. Applicant's arguments, see page 8, filed 18 November 2008, with respect to the rejection made under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejections of claims 1-7, 9, and 35 have been withdrawn.
6. Applicant's arguments with respect to the prior art rejections filed 18 November 2008 have been fully considered but they are not persuasive. The Applicant's arguments are based on the grounds the Declaration under 37 C.F.R. 1.131 was adequate to antedate U.S. Patent Application 2007/0118645 to Suturs, hereinafter Suturs.
7. The Declaration filed on 18 November 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Suturs reference. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Suturs reference to either a constructive reduction to practice or an actual reduction to practice.
8. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show

evidence of facts establishing diligence. See MPEP § 715.07(a). The applicant alleges the invention was conceived prior to 13 November 2003 (Suters' filing date) and the invention was constructively reduced to practice with the filing of the patent application on 22 March 2004. Therefore, the critical period for which the Applicant must show reasonable diligence is between 12 November 2003 and 22 March 2004.

9. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983). See MPEP § 2138.06. The Applicant alleges that he exercised due diligence from conception until the filing of the application on 22 March 2004 in item 6 of the Declaration. The Applicant fails to show any diligence prior to 14 November 2003 with Exhibit B showing the invention being submitted to outside counsel. The time period between 14 November 2003 when the invention was disclosed to outside counsel and 17 December 2003, when outside counsel submitted an outline of the application, is unaccounted for. Exhibit C apparently also requests feedback from the inventor which is not disclosed in the Declaration and would aid in showing diligence during the critical period between Exhibits C and D. Exhibit D shows that a draft application was submitted to the inventor on 29 January 2004. Exhibit E shows the inventor responding to the draft application on 04 March 2004, leaving the period between 29 January 2004 and 04 March 2004 unaccounted for as well. Finally, Exhibit F shows a final draft submitted to the inventor on 05 March 2004, yet does not account for the period between the

final draft and the submission of the application. Therefore, the Declaration is insufficient to antedate the Suturs reference because it does not account for the periods between 14 November 2003 and 17 December 2003; 17 December 2003 and 29 January 2004; 29 January 2004 and 04 march 2004; and 05 March 2004 and 22 March 2004 with affirmative acts or acceptable excuses.

10. See further rejections set forth below.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
12. Claims 1-7, 9-13, 15-18, 20, 28-32, 34-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2007/0118645 A1 to Suturs, hereinafter Suturs, in view of U.S. Patent No. 7,295,556 B2 to Roese et al., hereinafter Roese.
13. As per claims 1, 10 and 28, Suturs discloses an electronic device in a local area network, comprising:

a network interface that communicates with a connection point of the local area network, and that receives a polling signal from a security system in the local area network via the connection point (paragraph 0008, i.e. network manager device polls devices to see if they reply); and

a control that causes the network interface to communicate a response to the security system via the connection point in response to receipt of the polling signal (Figure 4 [block 401], paragraph 0039, i.e. receiving the state of a CE device), said control generates an alarm if said electronic device is not present (Figure 4 [blocks 402, 405], paragraph 0039, i.e. if the reception times out, meaning no response has been received, generating an alarm).

14. Suters does not teach a control causes the network interface to communicate the response to the security system as an encrypted message using an encryption code that is unique to the electronic device, wherein said message includes an address and an identifier associated with the electronic device and said control verifies that said electronic device is installed in an authorized network based upon said address and said identifier and wherein said user interface is configured to allow a user to arm and disarm building intrusion detection features separately from security features of said LAN.

15. Roese teaches a control causes the network interface to communicate the response to the security system as an encrypted message using an encryption code that is unique to the electronic device (Figures 5 [step 505], 7 [steps 710, 715], column 18, lines 4-15, column 25, lines 33-58, i.e. transmitting location information that may be encrypted with a key);

wherein said message includes an address and an identifier associated with the electronic device (column 36, lines 21-30, i.e. device specific information includes an IP address and a serial number) and said control verifies that said electronic device is installed in an authorized network based upon said address and said identifier (Figures 5 [steps 510, 520], 6 [steps 620, 620b, 620a], column 25, lines 41-58, column 27, line 52 to column 28, line 3).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a control causes the network interface to communicate the response to the security system as an encrypted message using an encryption code that is unique to the electronic device, wherein said message includes an address and an identifier associated with the electronic device and said control verifies that said electronic device is installed in an authorized network based upon said address and said identifier, since Roese states at column 6, line 56 to column 7,

line 7 that providing such features allows for the tracking of stolen devices which allows recovery or at the very least disabling access to sensitive information.

17. Suters and Roese does not disclose a user interface is configured to allow a user to arm and disarm building intrusion detection features separately from security features of said LAN.

18. It would have been obvious to one of ordinary skill in the art to provide an interface that arms/disarms a building intrusion detection system separately from the security features of a LAN, since one of ordinary skill in the art would clearly recognize that the building security features are a separate system from the network security features thereby requiring two separate interfaces for each system.

19. Examiner's NOTE: U.S. 2007/0118645 A1 qualifies as a 102(e) reference since it claims the benefit of an international application (WO/2005/048088). The International Application has met the following criteria to qualify the international filing date as the U.S. filing date: 1) the international filing date was after 29 November 2009 (11 November 2004); 2) it designated the United States; and 3) it was published under PCT Article 21(2) in English. Since the International Application properly claimed the benefit of an earlier filed U.S. provisional application, the Examiner is permitted to use the provisional application as the earliest possible filing date. See MPEP § 706.02(f)(1)(I)(C).

20. Regarding claims 2 and 11, Suters teaches the network interface communicates with at least one other electronic device in the local area network via the connection point to transfer

entertainment content (paragraph 0024, i.e. the electronic devices communicating and inspecting each other).

21. Regarding claim 3, Sutters discloses the network interface communicates, via the connection point, with a remote server that provides services for the electronic device (paragraphs 0024, 0030, 0031).

22. With regards to claim 4, Roese discloses the services include at least one of downloading software to the electronic device, performing remote programming of the electronic device (column 6, lines 11-23, i.e. system **100** can provision and configure devices), and uploading diagnostic data from the electronic device.

23. Regarding claims 5 and 16, Roese teaches discloses the connection point comprises at least one of a hub and a gateway (Figure 1 [element 114], column 31, lines 9-30).

24. Regarding claims 6 and 17, Roese discloses the network interface receives software from the security system via the connection point for configuring the electronic device as a sensor of the security system (column 6, lines 11-23, i.e. system **100** can provision and configure devices).

25. Regarding claim 7, Sutters discloses the security system sets an alarm if it does not receive the response from the network interface after sending the polling signal to the network interface (paragraph 0008, 0039).



26. Regarding claim 9, Roese teaches the control causes the network interface to communicate the response to the security system as an encrypted message using an encryption code that is unique for a specified group of electronic devices (column 18, lines 4-15, column 25, lines 33-58).

27. Regarding claim 12, Roese discloses the network interface communicates, via the connection point, with a remote server that provides services for the security system (column 6, lines 11-23, i.e. system **100** can provision and configure devices).

28. With regards to claim 13, Suters teaches when the alarm is set, the network interface communicates a message to the remote server indicating that the alarm has been set (paragraph 0039, i.e. alarm-alert or the device is in a protected state).

29. Concerning claims 15 and 31, Roese teaches the message comprises at least a portion of an Internet Protocol address associated with the electronic device (column 36, lines 21-30, i.e. device specific information includes an IP address).

30. Regarding claim 18, Suters teaches means for monitoring at least one sensor for detecting intrusion in a building (paragraph 0011, i.e. an anti-theft system).

31. Regarding claim 20, Roese teaches the response to the polling signal is provided as an encrypted message using an encryption code that is unique for a specified group of electronic devices (Figures 5 [step 505], 7 [steps 710, 715], column 18, lines 4-15, column 25, lines 33-58, i.e. transmitting location information that may be encrypted with a key).

32. Regarding claim 29, Suters teaches the message is received from the electronic device (paragraphs 0008, 0039).

33. Regarding claim 30, Roese teaches the message is received from a server that provides services for the electronic device (Figure 4 [step 440], column 25, lines 3-31).

34. Regarding claim 32, Roese teaches the identifier comprises a serial number (column 36, lines 21-30, i.e. device specific information includes a serial number).

35. Regarding claim 34, Roese teaches the message is received as an encrypted message using an encryption code that is unique for a specified group of electronic devices (column 18, lines 4-15, column 25, lines 33-58).

36. Regarding claims 35, 36, and 38, Suters and Roese do not teach the said control is configured to not allow spoofing of said electronic device.

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not allow spoofing of an electronic device, since one of ordinary skill in the art that

anti-spoofing techniques are well-known and commonly practiced in order to prevent unauthorized access to a network.

***Conclusion***

38. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

39. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian LaForgia whose telephone number is (571)272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christian LaForgia/  
Primary Examiner, Art Unit 2439

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